

REMARKS

Applicants have carefully considered the January 6, 2006 Office Action, and the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-13 are pending in this application. In response to the Office Action dated January 6, 2006, claims 6, 8 and 9 have been amended to correct minor typographical errors. No new matter has been entered. Entry of the present response is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated over Newmoyer (U.S. Pat. No. 5,814,406, hereinafter "Newmoyer"). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the electrical wire disclosed by

Newmoyer that would preclude the factual determination that Newmoyer identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 1 describes, *inter alia*, a buffered optical fiber having a second coating layer on an outer peripheral surface of an optical fiber produced by providing a first coating layer on an outer peripheral surface of a glass fiber.

Applicants respectfully submit that Newmoyer is directed to an electrical wire for transmitting electrical signals by the conductor (Figure 1) and, therefore, completely unrelated to the present claimed subject matter, namely optical fibers.

Applicants respectfully submit that Newmoyer is non-analogous prior art that cannot be applied against the present claimed subject matter. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058 (Fed Cir. 1992). If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed. *In re Wood*, 202 USPQ 171 (C.C.P.A. 1979). The Examiner is also charged to consider "'the reality of the circumstances' ... in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). With regard to this issue, the Examiner is also referred to M.P.E.P. § 2141.01, entitled "Analogous and Nonanalogous Art."

Whereas the claimed invention is directed to optical fibers for transmitting optical signal by the glass, the electrical wiring of Newmoyer is used for transmitting electrical signals by the conductor. Fig. 1 of the present invention discloses that the glass fiber 11 is present in the center

and claim 1 recites coating layers around the glass fiber. The present claimed optical fiber and the electrical wire of the applied reference are not only different from one another in terms of material, but also in the signal to be transmitted. Furthermore, the property which is required for the coating layer is different between the present invention and Newmoyer. Thus, the optical fiber of the claimed invention and the electrical wiring of Newmoyer are not within the same field of endeavor.

Furthermore, the claimed invention is directed to, in part, providing a buffered optical fiber which does not pollute its environmental system, has flame retardancy and excellent optical transmission (pages 2-3 of Applicants' disclosure). In contrast, Newmoyer describes a electrical wiring used in a plenum (compartment or chamber to which air ducts are connected and which forms part of an air distribution system). See cols. 1-2 of Newmoyer. Newmoyer is not reasonably pertinent to optical transmission or the problems associated therewith. Thus, the inescapable conclusion is that Newmoyer is non-analogous prior art that cannot be applied against the present claimed invention.

Accordingly, Newmoyer fails to identically disclose or suggest the claimed invention within the meaning of 35 U.S.C. § 102 and, therefore, the rejection should be withdrawn.

Claims 2-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Newmoyer in view of Ono et al. (U.S. Pat. App. Pub. No. 2003/0158309, hereinafter "Ono"). Applicants respectfully traverse.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 1 and 6-8 under 35 U.S.C. § 102(b) predicated upon Newmoyer. The secondary reference to Ono does not cure the argued deficiencies of Newmoyer. Ergo, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree

that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Claims 5 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Newmoyer. Applicants respectfully traverse. Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 1 and 6-8 under 35 U.S.C. § 102(b) predicated upon Newmoyer. Dependent claims 5 and 9-12 are free from the applied art in view of their dependency from claim 1. Accordingly, the rejection is not legally viable and should be withdrawn.

Independent claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Newmoyer in view of Caveney (U.S. Pat. App. Pub. No. 2003/0128938, hereinafter “Caveney”). Applicants respectfully traverse.

Independent claim 13 describes, *inter alia*, a buffered optical fiber terminated with a connector obtained by connecting a buffered optical fiber, wherein the buffered optical fiber has a second coating layer on an outer peripheral surface of an optical fiber produced by providing a first coating layer on an outer peripheral surface of a glass fiber.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 1 and 6-8 under 35 U.S.C. § 102(b) predicated upon Newmoyer. Independent claim 13 is free from the applied art for substantially the same reasons as independent claim 1. Moreover, the secondary reference to Caveney does not cure the argued deficiencies of Newmoyer. Thus, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp. supra*.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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